

1 Daniel Johnson, Jr. (State Bar No. 57409)
2 Brett M. Schuman (State Bar No. 189247)
3 Amy M. Spicer (State Bar No. 188399)
4 **MORGAN, LEWIS & BOCKIUS LLP**
5 One Market, Spear Street Tower
6 San Francisco, CA 94105-1126
7 Tel: 415.442.1000
8 Fax: 415.442.1001
9 djjohnson@morganlewis.com
10 bschuman@morganlewis.com
11 aspicer@morganlewis.com

7 ANDREW J. WU (State Bar No. 214442)
8 **MORGAN, LEWIS & BOCKIUS LLP**
9 2 Palo Alto Square
10 3000 El Camino Real, Suite 700
11 Palo Alto, CA 94306-2122
12 Tel: 650.843.4000
13 Fax: 650.843.4001
14 E-mail: awu@morganlewis.com

11 Attorneys for Plaintiffs and Counterdefendants
12 ALPHA & OMEGA SEMICONDUCTOR, INC.
13 ALPHA & OMEGA SEMICONDUCTOR, LTD.

14 UNITED STATES DISTRICT COURT
15 NORTHERN DISTRICT OF CALIFORNIA
16 SAN FRANCISCO DIVISION

18 ALPHA & OMEGA SEMICONDUCTOR,
19 INC., a California corporation; and
20 ALPHA & OMEGA SEMICONDUCTOR,
21 LTD., a Bermuda corporation,

21 Plaintiffs,

22 v.

23 FAIRCHILD SEMICONDUCTOR
24 CORP., a Delaware corporation,

24 Defendant.

25 AND RELATED COUNTERCLAIMS
26

Case No. C 07-2638 JSW

**ALPHA & OMEGA SEMICONDUCTOR,
INC.'S AND ALPHA & OMEGA
SEMICONDUCTOR, LTD.'S REPLY AND
AFFIRMATIVE DEFENSES TO
FAIRCHILD'S FIRST AMENDED
COUNTERCLAIMS**

DEMAND FOR JURY TRIAL

1 Alpha & Omega Semiconductor, Inc. (“AOS, Inc.”) and Alpha & Omega Semiconductor,
2 Ltd. (“AOS, Ltd.”) (collectively, “AOS”) respond to Fairchild Semiconductor Corp.’s
3 (“Fairchild”) first amended counterclaims as follows:

4 **JURISDICTION AND VENUE**

5 1. AOS denies that it has infringed or now infringes the patents asserted against AOS
6 in Fairchild’s counterclaims. AOS admits, without admitting the validity of Fairchild’s patent
7 infringement claims, that Fairchild’s counterclaims purport to state causes of action under the
8 patent laws of the United States. AOS admits that this Court has subject matter jurisdiction over
9 these purported claims under 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

10 2. AOS admits, for the purpose of this action only, that venue is proper in this
11 judicial district.

12 3. AOS admits, for the purpose of this action only, that this Court has personal
13 jurisdiction.

14 **PARTIES**

15 4. AOS lacks sufficient knowledge or information to admit or deny the allegations in
16 paragraph 4.

17 5. AOS admits that AOS, Inc. is a corporation duly incorporated under the laws of
18 the State of California with its principal place of business in Sunnyvale, California. AOS admits
19 that AOS, Ltd. is a Bermuda corporation.

20 **FIRST COUNTERCLAIM**

21 **(Declaratory Judgment of Non-Infringement)**

22 6. AOS realleges and incorporates by reference the responses stated in paragraphs 1-
23 5 above.

24 7. AOS admits that it is the owner by assignment of U.S. Patent Numbers 5,907,776
25 (the “‘776 patent”) and 5,767,567 (the “‘567 patent”).

26 8. AOS admits that an actual and justiciable case or controversy exists between
27 Fairchild on the one hand and AOS on the other. AOS admits that it has sued Fairchild alleging
28 infringement of the ‘776 and ‘567 patents.

1 9. AOS denies each and every allegation contained in paragraph 9.

2 10. AOS admits that Fairchild purports to seek a judicial determination from this
3 Court, but AOS denies that there is any basis for such a determination.

4 **SECOND COUNTERCLAIM**

5 **(Declaratory Judgment of Invalidity)**

6 11. AOS realleges and incorporates by reference the responses stated in paragraphs 1-
7 10 above.

8 12. AOS admits that an actual and justiciable case or controversy exists between
9 Fairchild on the one hand and AOS on the other. AOS admits that it has sued Fairchild alleging
10 infringement of the '776 and '567 patents.

11 13. AOS denies each and every allegation contained in paragraph 13.

12 14. AOS admits that Fairchild purports to seek a judicial determination from this
13 Court, but AOS denies that there is any basis for such a determination.

14 **THIRD COUNTERCLAIM**

15 **(Infringement of United States Patent No. 6,429,481)**

16 15. AOS realleges and incorporates by reference the responses stated in paragraphs 1-
17 5 above.

18 16. AOS admits that the title page of United States Patent No. 6,429,481 (the "'481
19 patent") states on its face that the patent was issued on August 6, 2002. AOS admits that on its
20 face, the '481 patent is entitled "Field Effect Transistor and Method of Its Manufacture." AOS
21 admits that on its face the '481 patent lists "Fairchild Semiconductor Corporation" as its assignee.
22 AOS admits that a copy of the '481 patent is attached to Fairchild's amended counterclaims as
23 Exhibit A. AOS denies that the '481 was duly and legally issued. AOS lacks sufficient
24 knowledge or information to admit or deny that Fairchild continues to hold all rights and interest
25 in the '481 patent. AOS denies any and all remaining allegations of paragraph 16 of Fairchild's
26 amended counterclaims.

27 17. AOS denies that it has been or currently is directly or indirectly infringing or
28 actively inducing or contributing to the infringement of the '481 patent. AOS denies any and all

1 remaining allegations of paragraph 17.

2 18. AOS denies each and every allegation contained in paragraph 18.

3 19. AOS denies each and every allegation contained in paragraph 19.

4 **FOURTH COUNTERCLAIM**

5 **(Infringement of United States Patent No. 6,710,406)**

6 20. AOS realleges and incorporates by reference the responses stated in paragraphs 1-
7 5 above.

8 21. AOS admits that the title page of United States Patent No. 6,710,406 (the “‘406
9 patent”) states on its face that the patent was issued on March 23, 2004. AOS admits that on its
10 face, the ‘406 patent is entitled “Field Effect Transistor and Method of Its Manufacture.” AOS
11 admits that on its face the ‘406 patent lists “Fairchild Semiconductor Corporation” as its assignee.
12 AOS admits that a copy of the ‘406 patent is attached to Fairchild’s amended counterclaims as
13 Exhibit B. AOS denies that the ‘406 was duly and legally issued. AOS lacks sufficient
14 knowledge or information to admit or deny that Fairchild continues to hold all rights and interest
15 in the ‘406 patent. AOS denies any and all remaining allegations of paragraph 21 of Fairchild’s
16 amended counterclaims.

17 22. AOS denies that it has been or currently is directly or indirectly infringing or
18 actively inducing or contributing to the infringement of the ‘406 patent. AOS denies any and all
19 remaining allegations of paragraph 22.

20 23. AOS denies each and every allegation contained in paragraph 23.

21 24. AOS denies each and every allegation contained in paragraph 24.

22 **FIFTH COUNTERCLAIM**

23 **(Infringement of United States Patent No. 6,521,497)**

24 25. AOS realleges and incorporates by reference the answers stated in paragraphs 1-5
25 above.

26 26. AOS admits that the title page of United States Patent No. 6,521,497 (the “‘497
27 patent”) states on its face that the patent was issued on February 18, 2003. AOS admits that on its
28 face, the ‘497 patent is entitled “Method of Manufacturing a Field Effect Transistor.” AOS

1 admits that on its face the '497 patent lists "Fairchild Semiconductor Corporation" as its assignee.
 2 AOS admits that a copy of the '497 patent is attached to Fairchild's amended counterclaims as
 3 Exhibit C. AOS denies that the '497 was duly and legally issued. AOS lacks sufficient
 4 knowledge or information to admit or deny that Fairchild continues to hold all rights and interest
 5 in the '497 patent. AOS denies any and all remaining allegations of paragraph 26 of Fairchild's
 6 amended counterclaims.

7 27. AOS denies that it has been or currently is directly or indirectly infringing or
 8 actively inducing or contributing to the infringement of the '497 patent. AOS denies any and all
 9 remaining allegations of paragraph 27.

10 28. AOS denies each and every allegation contained in paragraph 28.

11 29. AOS denies each and every allegation contained in paragraph 29.

12 **SIXTH COUNTERCLAIM**

13 **(Infringement of United States Patent No. 6,828,195)**

14 30. AOS realleges and incorporates by reference the answers stated in paragraphs 1-5
 15 above.

16 31. AOS admits that the title page of United States Patent No. 6,828,195 (the "'195
 17 patent") states on its face that the patent was issued on December 7, 2004. AOS admits that on its
 18 face, the '195 patent is entitled "Method of Manufacturing a Trench Transistor Having a Heavy
 19 Body Region." AOS admits that on its face the '195 patent lists "Fairchild Semiconductor
 20 Corporation" as its assignee. AOS admits that a copy of the '195 patent is attached to Fairchild's
 21 amended counterclaims as Exhibit D. AOS denies that the '195 was duly and legally issued.
 22 AOS lacks sufficient knowledge or information to admit or deny that Fairchild continues to hold
 23 all rights and interest in the '195 patent. AOS denies any and all remaining allegations of
 24 paragraph 31 of Fairchild's amended counterclaims.

25 32. AOS denies that it has been or currently is directly or indirectly infringing or
 26 actively inducing or contributing to the infringement of the '195 patent. AOS denies any and all
 27 remaining allegations of paragraph 32.

28 33. AOS denies each and every allegation contained in paragraph 33.

34. AOS denies each and every allegation contained in paragraph 34.

SEVENTH COUNTERCLAIM

(Infringement of United States Patent No. 7,148,111)

35. AOS realleges and incorporates by reference the answers stated in paragraphs 1-5 above.

36. AOS admits that the title page of United States Patent No. 7,148,111 (the “‘111 patent”) states on its face that the patent was issued on December 12, 2006. AOS admits that on its face, the ‘111 patent is entitled “Method of Manufacturing a Trench Transistor Having a Heavy Body Region.” AOS admits that on its face the ‘111 patent lists “Fairchild Semiconductor Corporation” as its assignee. AOS admits that a copy of the ‘111 patent is attached to Fairchild’s amended counterclaims as Exhibit E. AOS denies that the ‘111 was duly and legally issued. AOS lacks sufficient knowledge or information to admit or deny that Fairchild continues to hold all rights and interest in the ‘111 patent. AOS denies any and all remaining allegations of paragraph 36 of Fairchild’s amended counterclaims.

37. AOS denies that it has been or currently is directly or indirectly infringing or actively inducing or contributing to the infringement of the ‘111 patent. AOS denies any and all remaining allegations of paragraph 37.

38. AOS denies each and every allegation contained in paragraph 38.

39. AOS denies each and every allegation contained in paragraph 39.

EIGHTH COUNTERCLAIM

(Infringement of United States Patent No. 6,818,947)

40. AOS realleges and incorporates by reference the answers stated in paragraphs 1-5 above.

41. AOS admits that the title page of United States Patent No. 6,818,947 (the “‘947 patent”) states on its face that the patent was issued on November 16, 2004. AOS admits that on its face, the ‘947 patent is entitled “Buried Gate-Field Termination Structure.” AOS admits that on its face the ‘947 patent lists “Fairchild Semiconductor Corporation” as its assignee. AOS admits that a copy of the ‘947 patent is attached to Fairchild’s amended counterclaims as Exhibit

1 F. AOS denies that the '947 was duly and legally issued. AOS lacks sufficient knowledge or
 2 information to admit or deny that Fairchild continues to hold all rights and interest in the '947
 3 patent. AOS denies any and all remaining allegations of paragraph 41 of Fairchild's amended
 4 counterclaims.

5 42. AOS denies that it has been or currently is directly or indirectly infringing or
 6 actively inducing or contributing to the infringement of the '947 patent. AOS denies any and all
 7 remaining allegations of paragraph 42.

8 43. AOS denies each and every allegation contained in paragraph 43.

9 44. AOS denies each and every allegation contained in paragraph 44.

10 **AFFIRMATIVE AND OTHER DEFENSES**

11 Further responding to Fairchild's amended counterclaims, AOS asserts the following
 12 defenses. AOS reserves the right to amend its response with additional defenses as further
 13 information is obtained.

14 **FIRST DEFENSE**

15 **(Failure to State a Claim)**

16 45. Fairchild's counterclaims fail to state a claim against AOS upon which relief may
 17 be granted.

18 **SECOND DEFENSE**

19 **(Non-infringement of the Asserted Patents)**

20 46. AOS has not infringed, contributed to the infringement of, or induced the
 21 infringement of any valid claim of the '481, '406, '497, '195, '111, or '947 patents, and is not
 22 liable for infringement thereof.

23 47. Any and all products AOS makes that are accused of infringement in this action
 24 have substantial uses that do not infringe and therefore cannot induce or contribute to the
 25 infringement of the '481, '406, '497, '195, '111, or '947 patents.

26 48. No product AOS makes, uses, offers to sell, or imports into the United States or
 27 process AOS uses to make AOS's products infringes the '481, '406, '497, '195, '111, or '947
 28 patents.

THIRD DEFENSE

(Invalidity of the Asserted Patents)

49. AOS believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that one or more claims of the '481, '406, '497, '195, '111, and '947 patents are invalid for failing to comply with the provisions of the Patent Laws of the United States, including without limitation 35 U.S.C. §§ 102, 103, 112.

FOURTH DEFENSE

(Failure to Mark)

50. AOS believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that any claims for damages for alleged infringement are barred or limited due to failure to allege compliance with (and failure to comply with) the requirements of 35 U.S.C. § 287.

FIFTH DEFENSE

(Unavailability of Relief)

51. AOS believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that Fairchild has failed to plead and meet the requirements of 35 U.S.C. § 271(b) and (c) and that Fairchild is not entitled to any alleged damages prior to providing any actual notice to AOS of its claim of infringement of the '481, '406, '497, '195, '111, and/or '947 patents.

SIXTH DEFENSE

(Unavailability of Enhanced Damages)

52. AOS believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that Fairchild has failed to plead and meet the requirements of 35 U.S.C. § 284 for enhanced damages and is not entitled to any damages prior to providing any actual notice to AOS of the '481, '406, '497, '195, '111, and/or '947 patents.

SEVENTH DEFENSE

(Prosecution History Estoppel)

53. To the extent that Fairchild attempts to assert infringement under the doctrine of

1 equivalents, AOS believes that, after a reasonable opportunity for further investigation or
 2 discovery, it will be able to demonstrate that arguments and amendments contained in the
 3 prosecution history will estop or bar any claims for alleged infringement.

4 **EIGHTH DEFENSE**

5 **(Laches/Prosecution Laches/Estoppel)**

6 54. AOS believes that, after a reasonable opportunity for further investigation or
 7 discovery, it will be able to demonstrate that any claims for alleged infringement are barred or
 8 limited by the doctrine of laches, prosecution laches, and/or equitable estoppel.

9 **NINTH DEFENSE**

10 **(Adequate Remedy At Law)**

11 55. AOS believes that, after a reasonable opportunity for further investigation or
 12 discovery, it will be able to demonstrate that any claims for injunctive relief are barred in light of
 13 the fact that Fairchild has an adequate remedy at law.

14 **TENTH DEFENSE**

15 **(Res Judicata / Collateral Estoppel)**

16 56. Fairchild's amended counterclaims alleging infringement of the '481, '406, '497,
 17 and '195 patents are barred because of the doctrines of res judicata and collateral estoppel.

18 **PRAYER FOR RELIEF**

19 WHEREFORE, AOS prays for the entry of judgment as follows:

20 A. Dismissing with prejudice any and all of Fairchild's counterclaims and ordering
 21 that Fairchild take nothing as a result;

22 B. Awarding AOS its reasonable attorneys' fees, expenses and costs incurred in this
 23 action;

24 C. Granting AOS such other action and further relief as this Court may deem just and
 25 proper, or that AOS may be entitled to as a matter of law or equity.

26 //

27 //

28 //

1 Dated: October 18, 2007

MORGAN, LEWIS & BOCKIUS LLP

2
3 By /s/ Daniel Johnson, Jr.

4 Daniel Johnson, Jr.

5 Attorneys Plaintiffs and Counterdefendants
6 ALPHA & OMEGA SEMICONDUCTOR,
7 LTD., AND ALPHA & OMEGA
8 SEMICONDUCTOR, INC.

9 **DEMAND FOR JURY TRIAL**

10 AOS hereby requests a trial by jury.

11 Dated: October 18, 2007

MORGAN, LEWIS & BOCKIUS LLP

12
13 By /s/ Daniel Johnson, Jr.

14 Daniel Johnson, Jr.

15 Attorneys for Plaintiffs and Counterdefendants
16 ALPHA & OMEGA SEMICONDUCTOR,
17 LTD., AND ALPHA & OMEGA
18 SEMICONDUCTOR, INC.